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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,947	12/20/1999	DALE D. PETERSON	55288USA1A	1762

7590

07/30/2002

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EXAMINER

LEWIS, RALPH A

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/466,947

Applicant(s)

Peterson

Examiner

Ralph Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 1/18/2002

2a) ☒ This action is **FINAL**.

2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-4, 6-24, and 26-31 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-4, 6-24, and 26-31 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). _____

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6

6) ☐ Other:

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Rejections Based on Prior Art

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6, 17-19, 21-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson et al (6,007,929).

Note Figure 2 illustrating an article body 10 (a pipe column 3, line 28, a dull black pipe column 1, line 39) having a painted white topcoat (note column 3, lines 18-30). The white paint top coat includes a nitrocellulose binder (column 5, line 30) which meets the broadly claimed "polymer coating." In regard to the limitation that the coating have a genus identification mark and a spaced apart laser engraved identification mark being a species mark, one can readily look at Robertson et al Figure 2 label and recognize that a number of letters and numbers are provided for identifying the pipe. One could readily appreciate that the numbers and letters actually mean something and are not random, for example, the first number might represent the type of pipe material (i.e. genus - steel pipe) and the second number (spaced from the first) its length (i.e. species). Merely, providing for a logical classification of the labeled Robertson et al pipes would have been obvious to one of ordinary skill in the art.

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Claims 1, 4, 6, 17-19, 21-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (5,446,338).

Lee discloses an article 21 having a contrasting colored polymeric coating 40 which is then laser engraved with indicia. Lee fails to disclose what information the bar code 40 actually contains. One of ordinary skill in the art, however, could readily appreciate that the first numeral of the bar code could indicate whether the picture tube was black and white or color (genus) and the last numeral in the bar code (spaced from the first) could indicate the size of the picture tube (species). Merely providing for a logical organization of the labeled picture tubes of Lee would have been obvious to one of ordinary skill in the art.

Claims 2, 3, 13, 14, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (5,446,338) in view of Nierenberg (4,323,755).

In regard to claims 2 and 3, the laser engraving of the Lee polymeric layer 40 apparently does not pass through to the article surface (See Figure 3). Nierenberg, however, at lines column 4, lines 22-26, teaches that the contrasting indicia may be made by vaporizing "through the coating." To have vaporized through the Lee coating as taught by Nierenberg would have been obvious to one of ordinary skill in the art.

In regard to claims 13, 14, 29 and 30, Lee teaches that the adhesiveness of the polymeric coating is limited and the marker could fall off (note column 6, lines 9 and 10). It would have been obvious to have simply provided for a second marker or to have formed a less observable

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prior art marker in the work piece where it would not fall off as taught in Nierenberg so that one could readily identify the article if the Lee polymeric layer 40 came off. The limitations as to what applicant intends for the indicia on the label to represent fail to provide for any objectively ascertainable distinctions in the identification mark.

Claims 1-4, 6, 9, 15, 17-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (4,323,317) in view of Kulper et al (5,626,966) and Roberston (5,855,969).

Hasegawa discloses a container 7 having a label 8 attached thereto upon which a laser forms indicia. Hasegawa does not disclose the composition of the label. Polymeric labels which are inscribed by lasers are well known in the art as evidenced by Kulper et al and Robertson. To have merely selected a prior art polymeric label for the label of Hasegawa would have been obvious to one of ordinary skill in the art. The selection of a label color that provides contrast with the article so that one can find and read the label - is simply obvious, conventional and well known as evidenced by a stroll through a supermarket

Claims 1, 4, 6, 16-19, 21-24, 26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horng et al (5,322,436) in view of Robertson et al (6,007,929).

Horng et al teaches engraving orthodontic bands with a laser mark, but does not disclose the claimed polymeric layer. Robertson et al, however, teaches that by providing a contrasting

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colored polymeric layer on a metal surface which is laser engraved provides for a more easily readable marking. To have provided Horng et al with a contrasting polymeric layer on which laser mark 14 is formed so as to increase visibility of the mark would have been obvious to one of ordinary skill in the art.

Claims 7, 8, 10-12, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (4,323,317) in view of Kulper et al (5,626,966) and Roberston (5,855,969) as applied above and in further view of Grutzner (5,662,472).

Grutzner teaches the color coding of packages for dental materials. To have identified the Grutzner packages with labels as taught by Hasegawa so that one could readily ascertain their contents would have been obvious to one of ordinary skill in the art.

Prior Art

Applicant's information disclosure statement of April 30, 2002 has been considered and an initialed copy enclosed herewith.

Action Made Final


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Ralph Lewis at telephone number (703) 308-0770. After-Final Fax (703) 872-9303. The examiner works a compressed work schedule and is unavailable every other Friday.

R.Lewis
July 29, 2002



Ralph A. Lewis
Primary Examiner
AU3732